

Docket No: ICKINGER-2  
Appl. No: 10/689,572

### REMARKS

The last Office Action of August 18, 2005 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-9 are pending in the application. Claim 1 has been amended. No claims have been canceled or added. No amendment to the specification has been made. No fee is due.

Claims 1, 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stirn, of record in view of Okada et al., of record.

It is noted with appreciation that claims 2-7 are indicated allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. However, applicant wishes to defer amendments to these dependent claims in view of the arguments presented below regarding amended claim 1.

The present invention, as set forth in claim 1, has been summarized on page 11 in applicant's last communication, filed on May 20, 2005 and received by the U.S. Patent and Trademark Office on May 23, 2005. Without repeating this summary, it is noted that claim 1 relates to the arrangement of a spindle drive for implementing a linear movement of a plasticizing unit and the particular interrelationship between the spindle drive, an energy storage device and a control mechanism to thereby reduce energy consumption (compare e.g. [0007] and Abstract). In order to be clear on this point, claim 1 has been amended to set forth the relationship between the "spindle drive" and the "plasticizing unit".

The Stirn reference describes an apparatus for controlling an ejector mechanism. The ejector mechanism is used for extracting a molded product from the injection mold. In contrast thereto, the spindle drive of the present invention is used to operate a plasticizing unit by which starting material is plasticized for subsequent injection into the mold. Thus, as the requirements for a linear movement to operate a plasticizing unit, which need not directly interact with the

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injection mold, are different from the demands on an ejector mechanism to extract a finished product and interacts directly with the injection mold, a person skilled in the art would not consider the Stirn reference to solve the problem addressed by the present invention.

The ejector mechanism of Stirn is also not comparable with the spindle drive of the present invention because of the absence of interrelating threaded parts, such as threaded spindle and threaded nut which are in direct engagement. The ejector mechanism includes a transmission (44) interposed between a servo-motor (40) and an ejector arm (50) to convert a rotation by the servo-motor into a translatory motion of the ejector arm (50), see col. 4, lines 17-19. According to the Examiner, the motor is the equivalent to the drive element of the spindle drive, and the ejector arm is the equivalent to the spindle. Claim 1, on file, recited the provision of a spindle drive, without expressly setting forth the presence of a "spindle". The argumentation by the Examiner is thus confusing in this respect. However, as noted above, a spindle drive involves a threaded engagement between the nut and a spindle. This engagement is direct in contrast to Stirn which requires the presence of a transmission between the motor (equivalent to "nut") and the ejector arm (equivalent to "spindle").

The Okada reference also relates to the ejection-side of an injection molding machine and describes the provision of a vibration generator whose shaft (20) is moved back and forth through operation of a hydraulic circuit. Spring (30) is used to bias a rod member (28) and spring (34) is used to bias a covering member (33).

It is applicant's contention that a person skilled in the art of constructing a spindle drive for operating a plasticizing unit, as the present invention is directed to, would not consider references that describe ejection mechanisms, and combine them in a manner suggested. The fact that individual elements of the present invention can be found in the prior art is not determinative as to the question of obviousness. As stated by the Federal Circuit in *In re Rouffet*, 47 USPQ2d, 1453, 1457 "Most, if not all, inventions are combinations and mostly of

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old element. Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability."

Thus, there must be some motivation to combine references to create the case of obviousness, and a showing that a skilled artisan, confronted with the problems as the inventor, would select the elements from the cited prior art references.

It is applicant's contention, that the Examiner failed to make a prima facie case of obviousness and failed to explain the motivation one with no knowledge of applicant's invention would have to combine the references in a manner suggested.

It is also applicant's contention that the combination of Stirn and Okada would also not produce the present invention because neither one of those references discloses a spindle drive nor the combination of the spindle drive, energy storage device and control mechanism, as set forth in claim 1.

For the reasons set forth above, it is applicant's contention that neither Stirn nor Okada, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 1.

As for the rejection of the dependent claims 8 and 9, these claims depend on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection of claims 1, 8 and 9 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

Reconsideration and allowance of the present application are respectfully requested.

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Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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